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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/763,484

01/23/2004

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EXAMINER

ZEE, EDWARD

ART UNIT

PAPER NUMBER

2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/763,484	Applicant(s) MOULANA ET AL.	
	Examiner Edward Zee	Art Unit 2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the original filing of January 23, 2004. Claims 1-24 are pending and have been considered below.

Specification

2. The disclosure is objected to because of the following informalities: the examiner notes the use of acronyms (ie. CD-ROMS, ASPI, etc.) throughout the specification without first including a description in plain text as required.

Appropriate correction is required.

3. The use of the trademarks CloneCD© and BlindWrite© has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

4. Claims 6, 10, 22 and 24 are objected to because of the following informalities: the examiner notes the use of the acronym "CD-R/W" without first including a description in plain text as required. Appropriate correction is required.
5. Claims 7, 16, 17 are objected to because of the following informalities: the examiner notes a spelling error in the word "eraseable". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 9 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant claims performing the step of searching for a file on an optical medium before the type of medium being read by the optical drive is determined. The examiner will interpret this as searching for medium type code before determining the media type when considering the claims below.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner why one would search for a file on an optical medium containing the software program, in order to ensure that the optical medium contains the software program, if it was already established that the optical medium contains the software program. The examiner will interpret this claim as searching for a file before determining the media type when considering the claim below.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 4, 5, 7, 8, 9, 18-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Cookson et al. (5,896,454).

Claims 1, 4 and 21: Cookson et al. discloses a method and computer-readable optical medium containing instructions for preventing use of an unauthorized copy of a software program comprising the steps of:

a. determining a media type of an optical medium containing the software program [column 5, lines 23-27];

b. and inhibiting execution(*further play is aborted*) of the software program stored on the optical medium by preventing execution of the software program if the optical medium has media type that indicates that the optical media is copied [column 5, lines 44-49].

Claim 5: Cookson et al. discloses a method as in claim 1 above and further discloses that the step of determining the media type comprises inserting the optical medium in a drive of a computer and reviewing a medium-type code field contained in a mode parameter header(*lead-in section*) of the optical medium [column 3, lines 22-27].

Claim 7: Cookson et al. discloses a method as in claim 1 above and further discloses that a media type indicates that the optical medium is copied is one of a write-once media type and an

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erasable/rewriteable media type(*writeable disk*) [column 2, lines 24-25 and column 5, lines 39-48].

Claim 8: Cookson et al. discloses a method as in claim 1 above and further discloses the step of executing the software program stored on the optical medium if the step of determining determines the optical medium to be an optical read-only medium [column 5, lines 23-27].

Claim 9: Cookson et al. discloses a method as in claim 1 above and further discloses the step of searching for a file on the optical medium containing the software program prior to determining the media type to ensure that the optical medium contains the software program [column 2, lines 24-25 and column 5, lines 23-27]. The examiner notes that it is inherent to first find the medium type code stored in the lead-in section of the disk before being able to determine the media type.

Claims 18 and 23: Cookson et al. discloses a method and computer-readable optical medium containing instructions for preventing execution of an unauthorized copy of a software program stored on an optical medium comprising the steps of:

- a. determining a media type of the optical medium [column 5, lines 23-27];
- b. and executing the software program stored on the optical medium if the optical medium has a media type that indicates that the optical medium is an original version(*pressed disk*) [column 5, lines 23-27].

Claim 19: Cookson et al. discloses a method as in claim 18 above and further discloses that a read-only media type indicates that the optical medium is an original version [column 5, lines 23-27].

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Claim 20: Cookson et al. discloses a method as in claim 18 above and further discloses the step of inhibiting execution of the instructions if the optical medium does not have a read-only media type [column 5, lines 44-49].

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 3, 6, 10-17, 22 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Cookson et al. (5,896,454).

Claims 2 and 3: Cookson et al. discloses a method as in claim 1 above, but does not explicitly disclose that the step of inhibiting the execution of the software program comprises preventing execution of selected features of the software program by determining a set of features of the software program to execute. However, it would have been obvious to one of ordinary skill in the art at the time of invention to prevent execution of selected features of the software program. One would have been motivated to do so in order to allow execution of insignificant features of the software such as trial versions, previews, or purchasing information.

Claim 6: Cookson et al. discloses a method as in claim 5, but does not explicitly disclose that the drive is a CD-R/W drive. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a CD-R/W drive or any other optical media drive. One would have been motivated to do so in order to apply this method to other media formats.

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Claims 10 and 22: Cookson et al. discloses a method and computer-readable optical medium containing instructions for authenticating an original optical medium comprising the steps of inserting the optical medium in a drive of a computer(*player/recorder*) and checking a media type of the optical medium [column 4, lines 64-67 and column 5, lines 23-27], but does not explicitly disclose that the drive is a CD-R/W drive. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a CD-R/W drive or any other optical media drive. One would have been motivated to do so in order to apply this method to other media formats.

Claim 11: Cookson et al. discloses a method as in claim 10 above and further discloses the step of searching for a file on the optical medium prior to checking the media type [column 2, lines 24-25 and column 5, lines 23-27]. The examiner notes that it is inherent to first find the medium type code stored in the lead-in section of the disk before being able to determine the media type.

Claim 12: Cookson et al. discloses a method as in claim 10 above and further discloses that the step of checking a media type comprises reviewing a medium-type code field contained in a mode parameter header(*lead-in section*) of the optical medium [column 3, lines 22-27].

Claims 13-15: Cookson et al. discloses a method as in claim 10 above and further discloses:

- a. the step of checking the media type comprises verifying that the optical medium has a read-only media type and that it is indicative that the optical medium is an original version(*pressed disk*) [column 5, lines 23-27];
- b. the step of executing a software program stored on the optical medium if the optical medium has a read-only media type [column 5, lines 23-27] .

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Claim 16: Cookson et al. discloses a method as in claim 10 above and further discloses that the step of checking the media type comprises identifying if the media type is one of a write-once media type and an erasable/rewritable media type(*writeable disk*) [column 2, lines 24-25 and column 5, lines 23-27].

Claim 17: Cookson et al. discloses a method as in claim 16 above and further discloses the step of inhibiting execution of a software program stored on the optical medium if the step of checking identifies that the media type is one of a write-once media type and an erasable/rewritable optical media type [column 5, lines 39-48].

Claim 24: Cookson et al. discloses an electronic device comprising:

- a. memory for storing computer program instructions. The examiner notes that it is inherent for the device to have memory for storing computer program instructions if the device is executing the instructions;
- b. a processor for executing the stored computer program instructions [column 4, lines 42-43];
- c. and an optical drive(*player/recorder*) for receiving an optical medium containing a software program, the computer program instructions including instructions for determining the media type of the optical medium and inhibiting execution of the software program stored on the optical medium if the optical medium has media type that indicates that the optical medium is copied, but does not explicitly disclose that the optical drive is a CD-R/W drive [column 4, lines 40-42].

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However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a CD-R/W drive or any other optical media drive. One would have been motivated to do so in order to apply this method to other media formats.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Inokuchi et al. (7,039,848), Selinfreund et al. (2003/0219124) and Linnartz (6,314,518).

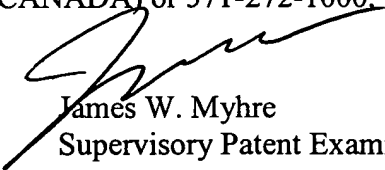
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Zee whose telephone number is (571) 270-1686. The examiner can normally be reached on Monday through Thursday 6:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571) 270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EZ
March 29, 2007



James W. Myhre
Supervisory Patent Examiner
